

## REMARKS

This Amendment responds to the final Office Action, dated October 20, 2004. Claims 51-63 were pending in this application. Claims 53-58 and 61-63 have been allowed. Claims 51 and 59 have been canceled. Claims 52 and 60 have been rewritten as independent claims incorporating the limitations of canceled claims 51 and 59. Claim 58 has been amended to correct a claim dependency. Claim 61 has been amended to delete the word "and." No new matter has been added by these amendments.

Upon entry of the present amendment, claims 52-58 and 60-63 will be pending. Reconsideration of the present application in view of the following remarks is respectfully requested.

Applicants respectfully request the Examiner to review the application file to verify that *two* requests for interference have been entered. The first, which was filed January 29, 2002, requested an interference with Bates *et al.* Patent No. 6,179,859 B1. The second, which was filed July 30, 2002, requested an interference with Bates *et al.* application No. 09/774,197, now Patent No. 6,468,291 B2. See Applicants' Identification of Patent Under 37 C.F.R. § 1.607(c), filed November 6, 2002. The Office Action, dated March 29, 2004, acknowledges the second request for interference, filed July 30, 2002, but no Office Action acknowledges the first request for interference, filed January 29, 2002, or Applicants' Identification of Patent, filed November 6, 2002.

In addition, none of the Office Actions have confirmed receipt of Applicants' three Information Disclosure Statements, filed January 29, 2002, April 10, 2002 and December 18, 2002.

Applicants respectfully request that the Examiner advise whether these two requests for interference, Applicants' Identification of Patent and three Information Disclosure Statements have been entered. If they have not been entered and are missing, Applicants will provide duplicate copies.

### I. THE REJECTION UNDER 35 U.S.C. § 102(E)

Claims 51 and 59 have been rejected under 35 U.S.C. § 102(e) as anticipated by Ladd, U.S. Patent No. 6,059,814. In order to expedite prosecution of this application, Applicants have canceled claims 51 and 59, without prejudice, thus obviating the rejection.

## **II. THE OBJECTION TO CLAIMS 52 AND 60**

Claims 52 and 60 have been objected to as being dependent on a rejected base claim. The Examiner indicated that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim. Claims 52 and 60 have been amended and now include all limitations of the base claim from which they depended. Thus, the rejection has been overcome.

## **III. THE MINOR AMENDMENTS TO CLAIMS 58 AND 61**

In reviewing the pending claims, Applicants noticed that prior claims 58 and 61 were not identical to the corresponding claims of the patents from which they were copied. Therefore, the claim dependency of claim 58 was changed so that it now depends from claim 56 and the word "and" was deleted from claim 61. These claims are now identical to claim 24 of Bates *et al.* Patent No. 6,179,859 B1 and claim 17 of Bates *et al.* Patent No. 6,468,291 B2, respectively. These minor amendments do not raise any new patentability issue.

## **IV. THERE IS INTERFERING SUBJECT MATTER CLAIMED BY APPLICANTS AND IN THE TWO BATES ET AL. PATENTS**

Applicants' claims 52-58 are *identical* to claims 2, 6, 7, 11, 21, 23 and 24, respectively, of Bates *et al.* Patent No. 6,179,859 B1 and Applicants' claims 60-63 are *identical* to claims 11, 17, 18 and 19, respectively, of Bates *et al.* Patent No. 6,428,291 B2.<sup>1</sup>

The captioned application claims priority under 35 U.S.C. § 120 as a continuation of application Serial No. 09/035,740, filed March 5, 1998, which issued as Patent No. 6,152,946 B1 on November 28, 2000. Bates *et al.* Patent No. 6,468,291 B2 claims priority as a continuation-in-part of application Serial No. 09/354,897, now Patent No. 6,179,859 B1, which was filed on July 16, 1999.

Since all of Applicants' claims 52-58 and 60-63 are entitled to an effective filing date of March 5, 1998, which is prior to July 16, 1999, the earliest possible filing date of both Bates *et al.* patents, Applicants would be senior party if an interference were declared between Applicants' captioned application and the two Bates *et al.* patents.

---

<sup>1</sup> Claims 11, 17, 18 and 19 of Patent No. 6,428,291 B2 originated as claims 12, 18, 19 and 20 of Bates *et al.* application No. 09/774,197. Since the patent had not yet issued at the time Applicants copied claims, the second request for interference copied claims from Bates *et al.* application No. 09/774,197.

V. **NOTICE OF COMMON OWNERSHIP**

Applicants advise the Examiner that the assignee of the captioned application is Scimed Life Systems, Inc. In addition, after Applicants' two requests for interference were filed, Scimed Life Systems, Inc. purchased Bates *et al.* Patent Nos. 6,179,859 B1 and 6,468,291 B2, from which Applicants had copied claims.

Despite this common ownership, the issue of priority as between Applicants and Bates *et al.* must still be resolved since Applicants claim subject matter that is claimed in the two Bates *et al.* patents.

Attorneys for Scimed Life Systems, Inc. have investigated and determined that Applicants are the first inventors of the subject matter of proposed counts 2 and 3. Scimed Life Systems, Inc. proposes to disclaim all claims of the two Bates *et al.* patents in order to remove those patents as impediments to issuance of Applicants' claims. No interference would be necessary. Prior to filing any disclaimers, however, Applicants seek the Examiner's agreement that, upon filing the disclaimers, Applicants claims will issue.

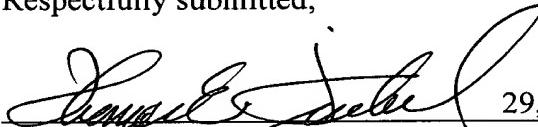
VI. **CONCLUSION**

All of Applicants' claims 52-58 and 60-63 should be allowable upon entry of this Response. In light of the above remarks, Applicants respectfully request that the Examiner issue all of Applicants' claims upon disclaimer of claims 1-26 of Bates *et al.* Patent No. 6,179,859 B1 and a disclaimer of claims 1-19 of Bates *et al.* Patent No. 6,468,291 B2.

The Examiner is invited to call the undersigned attorney at (212) 326-3939, if a telephone call could help resolve any outstanding issues.

Respectfully submitted,

Date: April 1, 2005

  
Thomas E. Friebel 29,258  
(Reg. No.)  
JONES DAY  
222 East 41st Street  
New York, New York 10017  
(212) 326-3939